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In re Application of :
Teumer et al. :
Serial No.: 10/534,428 : PETITION DECISION
Filed: May 10, 2005 :
Attorney Docket No.: 50393/004001 :
:

This is in response to the petition under 37 CFR § 1.181, filed September 20, 2007, requesting that the finality of the Office action of March 12, 2007 be withdrawn.

BACKGROUND

The examiner mailed a non-final Office action on August 22, 2006, setting a three month shortened statutory period for reply. In this action, claims 16 and 29-31 were rejected under 35 U.S.C. 112, second paragraph as being indefinite. Claims 1, 7-10, 13, 17, and 19 were rejected under 35 U.S.C. 102 (b) as being anticipated by WO 99/01034. Claims 1-15, 17, 19-21, 29, and 32 were rejected under 35 U.S.C. 103 (a) as being unpatentable over WO 99/01034 and WO 00/69449 in view of Keller et al (Frontiers in Bioscience, 1996), Hibberts et al (Journal of Endocrinology, 1998) and Van Nispen (US 5,002,881, 1991). Claims 1, 18, and 33 were also rejected under 35 U.S.C. 103 (a) as unpatentable over WO 99/01034. Claims 34-50 were withdrawn as being drawn to a non-elected invention.

In response to the non-final Office action, applicants amended claims 1, 9, 16, 30, and 31 on January 25, 2007. Applicants also argued the rejections set forth in the action and canceled claims 2-6.

The examiner mailed a final Office action on April 20, 2007, setting a three month shortened statutory period for reply. In this Office action, claims 1, 7-21, and 29-33 were rejected under 35 U.S.C. 103 (a) as being unpatentable over WO 99/01034 and WO 00/69449 in view of Keller et al (Frontiers in Bioscience, 1996), Hibberts et al (Journal of Endocrinology, 1998) and Van Nispen (US 5,002,881, 1991).

In response thereto, applicants filed this petition on September 20, 2007, requesting that the finality of the Office action of April 20, 2007 be withdrawn.

DISCUSSION

Applicants argue that on "August 22, 2006, the Office issued a non- final action rejecting claims 16 and 29-31 for indefiniteness, claims 1, 7-10, 13, 17, and 19 for anticipation by WO 99/01034, claims 1-15, 17, 19-21, 29, and 32 for obviousness over WO 99/01034, WO 0069499, Keller et al. (Frontiers in Bioscience, 1996; hereinafter "Keller"), Hibberts et al. (Journal of Endocrinology, 1998; hereinafter "Hibberts"), and Van Nispen (U.S. Patent No. 5,002,881; hereinafter "Van Nispen'), and claims 1, 18, and 33 for obviousness over WO 99/01034."

Applicants also point out that in their reply of January 22, 2007, applicants narrowed independent claim 1 to recite that the culture medium is conditioned by prostate epithelial cells. Applicants further point out that their amendments and arguments overcame the indefiniteness and anticipation rejections but the Office action finally rejected claims 1, 7-21, and 29-33 for obviousness over the combination of WO 99/01034, WO 0069499, Keller, Hibberts, and Van Nispen for the reasons given in the prior non-final Office Action. Applicants finally point out that the Office action stated that the reason for making the Office Action final was that "Applicant's amendment necessitated the new ground(s) of rejection presented in the Office action."

Applicants' arguments are not persuasive. The first Office action of August 22, 2006 rejected the claims under 37 CFR 103(a) over WO 99/01034 and WO 00/69449 in view of Keller et al (Frontiers in Bioscience, 1996), Hibberts et al (Journal of Endocrinolgy, 1998) and Van Nispen (US 5,002,881, 1991) as did the rejection in the final Office action. To the extent that the final rejection was necessitated by amendment, only the claim numbers rejected were modified and this only due to claim amendments and cancellation of claims. The same grounds were set forth in the final Office action along with arguments as to why the rejection should be maintained. It is quite apparent that the examiner has merely maintained the rejection of record and that no actual "new" grounds were set forth. Therefore, the Office action of April 20, 2007 was properly made final.

DECISION

The petition is **DENIED**. Any new or renewed petition must be filed within TWO MONTHS of the mail date of this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.


Bruce Kisliuk
Director, Technology Center 1600